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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,371	03/04/2002	Peng Wang	25885-704	7248
21971	7590	07/13/2004	EXAMINER	
WILSON SONSINI GOODRICH & ROSATI			LEITH, PATRICIA A	
650 PAGE MILL ROAD			ART UNIT	
PALO ALTO, CA 943041050			PAPER NUMBER	
			1654	

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/091,371	<b>Applicant(s)</b> WANG ET AL.	
	<b>Examiner</b> Patricia Leith	<b>Art Unit</b> 1654	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 April 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Claims 1-19 are pending in the application.

It is noted that Applicant has labeled claims 2, 4 and 5 as being withdrawn from further examination on the merits. However, these claims are pending and were examined on the merits in the first Office Action sent 10/21/03. In subsequent responses, Applicant is asked to label these claims as 'pending'.

Claims 1-19 were examined on the merits.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a previous Office Action.

### ***Specification***

The disclosure remains objected to because of the following reason:

The disclosure does not contain a Brief Description of the Drawings as required by 37 CFR 1.74. Applicant is asked to submit a Brief Description of the Drawings into the Specification without the addition of new matter. Applicant did not file a Brief Description to the drawings as required by the previous Office Action.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

Claims 1-19 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-19 either recite the term, or dependant upon a claim which recites the term 'Prunella Linn'. This plant is deemed indefinite because it is not found in the art, and Applicant has not described this plant in such a way in order to assure that the ordinary artisan would know if they were in possession of this plant, therefore making the plant name arbitrary and indefinite. Applicant is asked to submit evidence that this particular plant is documented in the literature in order to overcome this rejection. Applicant's arguments were fully considered and will be answered *infra*.

Claims 1-19 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention.

Applicant's arguments were fully considered but not found persuasive.

Applicant has provided an excerpt from "FLORA" (1977) which allegedly shows that *Prunella Linn* "is a known and well documented in an authoritative publication" (p.6-Arguments). Hence, Applicant contends that this is sufficient evidence to overcome the current rejection.

However, the Examiner respectfully disagrees for the following reasons:

First, Applicant alleges that "FLORA" contains a teaching of '*Prunella Linn*' but has not provided any certified translation of the excerpt. Therefore, the Examiner cannot verifiably conclude that "FLORA" actually contains such a teaching.

Secondly, it is noted that even if "FLORA" contains a teaching of '*Prunella Linn*', it is the Examiner's opinion that "FLORA" is referring to the genus '*Prunella*' which has different species thereof; i.e., *grandiflora*, *vulgaris*, *lanceolata*, *laciniata* and *hyssopifolia* as examples. The Instant specification only taught '*Prunella Linn*' and did not teach any specific species of *Prunella*. Thus, 1) *Prunella Linn* is not considered a genus/species of plant (in terms of botanical nomenclature) until it is clearly demonstrated as such. Because this plant cannot be found in the art and because Applicant has not provided any indication of where to purchase the plant or even seeds thereof, the skilled artisan

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would not be able to make or use the Instant invention as currently claimed and 2) if Applicant intends for "Prunella Linn" to mean the genus "Prunella" Applicants have not disclosed *which* species of Prunella provides for the invention as Instantly claimed and therefore pose a serious burden on the skilled artisan in order to ascertain what species of Prunella the claims are referring to.

Applicant's specification fails to describe the Instantly claimed invention so as to enable the worker of ordinary skill in the art to determine the subject matter which the instant claims encompass. Although the specification contains examples of processes for preparing the instant complexes, no adequate definition or description of the product, in the Instant case, 'Prunella Linn', per se, is set forth. Upon a thorough reading of the specification as filed, the worker of ordinary skill in the art is not provided with an adequate definition of 'Prunella Linn' as claimed. It may be true the Applicant is able to make the invention, however the application is directed toward one of ordinary skill in the art. It is not seen the claims are set forth in clear, concise and exact terms to enable someone other than the Applicant to make the invention which is a requirement of the statute.

No Claims are allowed.

### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia Leith whose telephone number is (571) 272-0968. The examiner can normally be reached on 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on (571) 272-0961. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patricia Leith  
Primary Examiner  
Art Unit 1654

06/29/04

A handwritten signature in cursive script, reading "Patricia Leith", written in black ink.